

### REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-4 and 6 are rejected under 35 USC 102(b) over the International patent document to Wolf in view of the U.S. patent application publication to Stierle.

Claim 7 is rejected under 35 USC 103(a) over the same references.

Claim 5 is rejected under 35 USC 103(a) as above in view of the U.S. patent to Shull.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicants cancelled Claim 2 and introduced its features into Claim 1. It is respectfully submitted that the new features of the present invention which are now defined in Claim 1 are not disclosed in the prior art applied by the Examiner against the original claims.

It is known in the prior art to drive the switch means for deflecting the measurement signal between the emission branch and the

reference branch. However, it is not known in the prior art that this mechanical work is performed by a user at a control element of the device.

Typically such a switch means in accordance with the prior art is driven via an electric motor or an electromagnetic relay. The switch means is supplied with electrical energy, converted into a mechanical work, which is used for a movement of the switch means, for example, a reference flap.

In the device for optical distance measurements in accordance with the present invention, to the contrary, the energy for adjustment of the adjusting element is produced as a mechanical energy by a user. This is, for example, carried out in that the user presses a measuring button for activation of a distance measurement. The mechanical work directed to the button is transmitted via a mechanical coupling element to the switch means, which then, for example release the emission branch of the device. In connection with this, reference can be made to Figures 3 and 4, in which this cooperation is illustrated. The corresponding description of these features can be found in the specification starting from the last paragraph on page 8.

A device in which the switch means are driven by mechanical work that is performed by a user at a user control element of the device is not disclosed in the prior art.

The patent to Wolf does not disclose at all a switching element or switch means, which are driven by a mechanical work that is performed by a user at a user control element.

This can be clearly seen from the Wolf reference in the last paragraph on page 8:

“In the emission branch of the inventive device according to Figure 2, a device (70) is located for generating a device-interior reference streak (72) with which an internal calibration of the measuring device can be performed.”

No other features related to the switch means are disclosed in this reference.

This reference therefore does not disclose the new features of the present invention as now defined in amended Claim 1. The other references applied in combination also do not disclose these features of the present invention.

The Examiner rejected the claims as being anticipated. It is believed to be clear that the prior art does not disclose the above-mentioned new features of the present invention as defined in Claim 1. In connection with this it is believed to be advisable to cite the decision In Re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the prior art does not disclose each and every element of the present invention as now defined in amended Claim 1, and therefore the anticipation rejection should be considered as not tenable with respect to Claim 1 and should be withdrawn.

It should be also mentioned that the references do not provide any hint, suggestion, or motivation for the new features of the present invention as defined in amended Claim 1. In order to arrive at the present invention from the prior art, the prior art has to be modified, and in particular by including into the references the new features of the present invention which are now defined in amended Claim 1 and were first proposed by the applicants. However, it is known that in order to arrive

at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments, it is believed that Claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on Claim 1, they share its allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance,

then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', written over the printed name.

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